

REMARKS

Claims 1-9 and 11-18 were pending in the present application. By virtue of this response, claims 1, 8, and 11 have been amended and no claims have been cancelled or added. Accordingly, claims 1-9 and 11-18 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Support for the amendments to claims 1 and 11 may be found throughout the present application. Accordingly, no new matter has been added.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 1, 8, and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner states the terminology "therebetween" is unclear in the claims. Applicants believe the claim language is sufficiently clear under 35 U.S.C. § 112, second paragraph, but have amended claims 1, 8, and 11 to replace the phrase "therebetween" with appropriate features to expedite prosecution of the application. No new matter has been added by the amendments. Accordingly, Applicants respectfully request withdrawal of the rejection.

Further, with regard to claim 1 and the claim language "and cooperating with the thrust plate to define a fluid thrust bearing," the Examiner states it is unclear what is cooperating with the thrust plate. Applicants believe the claim language is sufficiently clear under 35 U.S.C. § 112, second paragraph, but have amended claim 1 to clarify that "the sleeve" is cooperating with the thrust plate to expedite prosecution of the application. No new matter has been added by the amendments. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejections under 35 U.S.C. § 103(a)

Claims 1-9 and 11-18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Oku (U.S. Patent No. 6,097,121) in view of Moritan et al (U.S. Patent No. 5,822,846) and Kunze et al (U.S. Patent No. 5,743,015).

Applicants respectfully submit that Oku, Moritan, and Kunze, alone or in combination, fail to disclose or suggest a spindle motor including “a counterplate laser welded to the sleeve,” as recited by amended claim 1. In particular, the cited references do not disclose or suggest laser welding the counterplate to the sleeve. Similarly, independent claims 8 and 11 recite “a counterplate laser welded to upraised axial arms of said sleeve.” Support for the amendment to claims 1, 8, and 11 is found, for example, in paragraph [0017] of the present application. Laser welding the counterplate to the sleeve provides, for example, a continuous seam, hermetic seal between the counterplate and the sleeve and has advantages over o-ring and adhesive seals, as discussed in the present application in paragraphs [0018] and [0019]. Such a feature is neither disclosed nor suggested by the applied references and the rejection should be withdrawn.

Furthermore, even assuming the applied references disclose all the features of the present claims, Applicants submit that the Examiner has failed to establish a teaching, suggestion, or motivation to combine Oku, Moritan, and Kunze to meet the features of the present claims, and has therefore failed to present a *prima facie* case of obviousness. In particular, the Examiner has failed to provide evidence or a convincing line of reasoning as to why an artisan would find the present claims obvious in light of the applied references. See, MPEP § 2142. The Examiner states:

“Moritan et al discloses for the purpose of discharging confined air from the bearing and avoid lubricant leakage that the counter plate 22 can be welded to parts of the motor such as the sleeve 27 (see figure 2a, column 2, lines 9-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a spindle motor as disclosed by Oku and to modify the invention by welding the counter plate to the motor for the purpose of discharging confined air from the bearing and avoid lubricant leakage as disclosed by Moritan et al and to further disclose the use of welding a plate to a sleeve for

the purpose of securing effectively a shaft rapidly and reliably in a hole in a metal mounting plate in an axial position as disclosed by Kunze et al.”

Applicants respectfully disagree with the Examiner and submit that the Examiner is engaging in impermissible hindsight analysis. The portion of Moritan relied upon by the Examiner does not disclose or suggest welding the thrust plate to the motor for the purpose of preventing lubricant leakage; rather, the purpose is for reducing the “thickness or height” of the motor. See, col. 1, line 65-col. 2, line 63. Although the invention of Moritan relates to the effective discharge of air or bubbles from the bearing, the purpose of the welding is clearly stated – to reduce the height occupied by the thrust bearing part of the motor to be as small as possible. See, col. 2, lines 1-11. Accordingly, Moritan clearly does not disclose or suggest the act of welding to reduce or avoid lubricant leakage.

In stark contrast to Moritan, features of the present claims are directed “to more efficiently and economically seal[ing] a hydrodynamic bearing incorporated with a spindle motor.” (see, e.g., paragraphs [0006]-[0008], [0012] of the present application). Accordingly, one skilled in the art would not have been motivated to combine features of Moritan (described therein to solve problems associated with discharging air from bearings) to solve the problems of sealing a hydrodynamic bearing. Accordingly, the Examiner has not identified anything that would suggest modifying Oku to meet the features of the present claims. That is, the Examiner has not identified anything that would suggest why one of ordinary skill in the art would combine the references, let alone combine and modify the references, to meet the specific features of the present claims. Therefore, the rejection should be withdrawn because the Examiner has failed to establish a suggestion, teaching, or motivation in the prior art such as a specific understanding or technical principle that would have suggested the desirability of the combination to meet the specific features of the present claims. See, *In re Rouffet*, 149 F.3d at 1350, 1357 (Fed. Cir. 1998); MPEP §§ 2142, 2143.01 (“The prior art must suggest the desirability of the claimed invention”).

Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of all claims.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 146712007200. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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